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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,587	08/15/2000	Joseph F. Scalisi	30639.2600	5402

7590 11/17/2004
GREENBERG TRAURIG LLP
2450 Colorado Avenue
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EXAMINER

BANGACHON, WILLIAM L

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/638,587

Applicant(s)

SCALISI ET AL.

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-10 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 5-10 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Objection to the abstract is withdrawn.

Claim Rejections - 35 USC § 112

2. The rejection to claims 5-10 under 35 U.S.C. 112, second paragraph, is withdrawn.

Oath/Declaration

- m.jh.*
3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application-by-application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not include inventor Lawrence Hecox's signature.

Response to Arguments

4. Applicant's arguments filed 2/23/04 have been fully considered but they are not persuasive.
5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the message asks a call receiver at the preprogrammed telephone number to

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initiate a call to said call receiving pager apparatus in order to establish direct two-way communication" {pg. 9, 2nd paragraph}, "a requested callback by the subscriber/user of the present invention is needed in order to establish direct two-way communication between an outside caller and the user" {page 9, 3rd paragraph}, "the caller would receive the call back request and then must call the user/subscriber of the call receiving pager apparatus to initiate direct two-way communication, something the user/subscriber of the call receiving pager apparatus cannot do when transmitting the request" {pg. 9, last paragraph}) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no indication in the claims that the message sent by the user is a request to call back or the caller must call the user in order to initiate a direct two-way communication, and the user cannot initiate direct two-way communication. The claims are broader than what applicant argues. In this case, the claims are broadly interpreted as conventional communication routine used by pagers and cellphones wherein a cellphone sends a text message to another cellphone. In response to this text message, said another cellphone sends a text message.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (page 10, 1st paragraph), it must be recognized that any judgment on obviousness is in a sense necessarily a

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reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 5, 18-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/499,058.

Application No. 09/499,058 is directed to a call receiving pager apparatus having a directory inbound dialing number associated therewith; **a dedicated switch** having storage means for storing said directory inbound dialing number and both a mobile identification number and a verification encoding signal associated with said directory

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inbound dialing number; means for establishing two way communication between a caller and a subscriber of said call receiving pager apparatus, wherein **said dedicated switch enables caller only initiated direct two-way wireless communication between a caller and a subscriber of said call receiving pager apparatus**; and means for identifying the verification encoding signal associated with the directory inbound dialing number and transmitting the verification encoding signal from the dedicated switch to the caller receiving pager apparatus to verify that a code received from the dedicated switch matches a code preprogrammed into the call receiving pager apparatus". In this case, establishment of the two-way communication between the caller and the subscriber of the call receiving pager apparatus are as follows; the subscriber of the call receiving pager apparatus initiates a call, via the dedicated switch, to the caller. In this instance, a two-way communication between the subscriber and the caller cannot be established because the call receiving pager apparatus cannot make outgoing calls. It only initiates the caller to call the receiving pager apparatus. Only the caller, via the dedicated switch, can establish a two-way wireless communication between the caller and the subscriber of the call receiving pager apparatus (see figure 15).

The instant invention is directed to a call receiving pager apparatus wherein "the message asks a call receiver at the preprogrammed telephone number to initiate a call to said call receiving pager apparatus **in order to establish direct two-way communication**" {pg. 9, 2nd paragraph}, "a requested callback by the subscriber/user of the present invention is needed **in order to establish direct**

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two-way communication between an outside caller and the user" {page 9, 3rd paragraph}, "the caller would receive the call back request and then must call the user/subscriber of the call receiving pager apparatus to initiate direct two-way communication, something the user/subscriber of the call receiving pager apparatus cannot do when transmitting the request" {pg. 9, last paragraph}) as claimed in claim 5. Claims 18-26 are directed to a dedicated switch that is utilized to implement a caller only initiated call. Obviously, this is a variation of the call receiving pager apparatus of Application No. 09/499,058 utilizing a dedicated switch, to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 5-10 and 18-26 are rejected under 35 U.S.C. 103(a) as obvious over USP 5,117,449 (Metroka et al) in view of USP 5,574,772 (Scalisi et al), and further in view of USP 6,226,495 (Neustein).

In claim 5, Metroka et al teach of a call receiving pager apparatus (figures 1 and 2) operative in a radiotelephone communications system {see whole document} comprising:

receiving means (105, 110) for receiving cellular signals {col. 1, lines 41-45; col. 3, lines 9-16};

transmitting means (109) for

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a) transmitting cellular signals upon receipt of cellular signals by said receiving means to create a direct real-time two-way wireless communication between said call receiving pager apparatus and another telephone apparatus and {col. 1, lines 41-45; col. 4, lines 31-41, lines 54-55; col. 5, lines 45-59; col. 6, lines 31-40};

b) transmitting at least one of a voice message, a text message, or data message to a telephone number preprogrammed into said call receiving pager apparatus wherein said message asks a call receiver at said preprogrammed telephone number to initiate a call to said pager apparatus {col. 1, lines 26-30; col. 2, lines 19-23; col. 6, lines 11-65};

processing means (106) coupled to the receiving means (105, 110) and the transmitting means (109) for

a) processing said received cellular signals and only transmitting cellular signals in response to receipt of a signal having a correct mobile identification number of the pager apparatus {col. 1, lines 54-59; col. 6, lines 30-65},

b) producing an alert signal in response to receipt of a signal having the correct mobile identification number of the pager apparatus {col. 2, lines 31-36; col. 3, lines 40-42}, and

c) producing at least one of a voice message and a text message {col. 6, lines 31-40}; and

means for indicating reception of cellular signals coupled to the processing means {col. 1, lines 31-36; col. 2, lines 31-36; col. 3, lines 40-42, lines 60-65}.

Based on applicant's arguments, Metroka et al does not teach **"a requested callback by the subscriber/user of the present invention is needed in order to establish direct two-way communication between an outside caller and the user"** {page 9, 3rd paragraph}, or **"the caller would receive the call back request and then must call the user/subscriber of the call receiving pager apparatus to initiate direct two-way communication, something the user/subscriber of the call receiving pager apparatus cannot do when transmitting the request"** {pg. 9, last paragraph}). However, these claim limitations are conventional as evidenced by Scalisi et al and would have been obvious in the system of Metroka et al to one of ordinary skill in the art ordinary skill in the art.

Scalisi et al teach of a caller only initiated, direct two-way wireless communication between a caller and a subscriber of the call receiving pager apparatus {see whole document}. Scalisi et al suggests that it will drastically reduce the chances of fraud occurring {Scalisi et al, col. 2, lines 1-12}. Clearly, this is desirable in the system of Metroka et al.

The systems of Metroka et al and Scalisi et al are analogous art because they are from same field of endeavor, combined pager and telephone. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to implement a caller only initiated, direct two-way wireless communication between a

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caller and a subscriber of the cellular telephone of Metroka et al, as taught by Scalisi et al, because this will drastically reduce the chances of fraud occurring.

Further, Neustein teaches of a caller only initiated communication between a caller and a subscriber of the call receiving pager apparatus wherein the caller is billed for the transmission of the call {col. 4, lines 22-26; col. 7, lines 1-10; col. 9, lines 52-59}. When the caller's profile matches the type of profile stored for the call receiving pager apparatus (such as ID, actual name of the caller {paragraph bridging cols. 4 and 5; col. 6, lines 4-49}), the caller is billed and only then will the call go through {col. 15, lines 52-62; col. 16, lines 56-61}. Clearly, this is desirable in the system of Metroka et al because not only will the cost of unauthorized calls from the cellular telephone be reduced, but the cost of operating the cellular telephone is also reduced (i.e. no incoming call fees). The system of Neustein and Metroka et al are analogous art because they are from same problem solving area. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a caller only initiated communication between a caller and a subscriber of the call receiving pager apparatus wherein the caller is billed for the transmission of the call in the system of Metroka et al, as evidenced by Neustein, because not only will the cost of unauthorized calls from the cellular telephone be reduced, but the cost of operating the cellular telephone is also reduced.

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In claim 6, the apparatus of Claim 5 further comprising an ability for a user of the call receiving pager apparatus to receive text messages and send text messages to outside callers who previously called the apparatus {Metroka et al, col. 3, lines 1-8; col. 6, lines 18-30}.

In claim 7, the apparatus of Claim 6 further comprising storage means for storing a caller's text message and a caller telephone number relating to the caller in the event that the user of the apparatus fails to respond to text message sent by the caller {Metroka et al, col. 6, lines 18-40}.

In claim 8, the apparatus of Claim 7 further comprising search means for searching stored telephone numbers of callers who have previously called the apparatus {Metroka et al, col. 6, lines 18-40}.

In claim 9, the apparatus of Claim 6 further comprising means for forming a text message with the apparatus which includes at least one of an alpha keypad (102) on the apparatus, a machine user interface (103) on the apparatus, and a separate device connected to the apparatus by a serial data input socket which can program information into the apparatus {Metroka et al, col. 3, lines 33-40; col. 6, lines 41-65}.

In claim 10, the apparatus of Claim 5 further comprising means for allowing the caller to select at least one of a prerecorded voice or text {Metroka et al, col. 6, lines 9-40}.

Claims 18-26 are directed to utilizing a dedicated switch having a database for storing a directory inbound dialing number and a mobile identification number and a lookup table for verification {Scalisi et al, col. 2, lines 41-46; Neustein, fig. 2}.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Examiner Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is (571)-272-3065. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571)-272-3068. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is (571)-273-3065 for informal communications.

Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

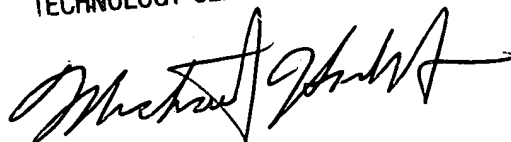
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William L Bangachon
Examiner
Art Unit 2635

November 15, 2004

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read "Michael Horabik", written over the printed name and title.